

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS J. SLAGA,
DARYL L. DELUCA and
WILLIAM S. SPARKS

Appeal No. 1996-2436
Application 07/887,451

ON BRIEF

Before WINTERS, WILLIAM F. SMITH, and ADAMS, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner's decision rejecting claims 1 and 20 through 22. Claims 2 through 19, which are the only other claims remaining in the application, stand withdrawn from further consideration by the examiner as directed to a non-elected invention.

Claim 1, which is illustrative of the subject matter on appeal, reads as follows:

1. A method of inhibiting two-stage skin carcinogenesis - promoting effects of carcinogens in an animal, the method comprising administration of prophylactically effective amounts of a dietary supplement to an animal, wherein the supplement includes: BHA or BHT; vitamin E; and β -carotene.

The prior art reference relied on by the examiner is:

Amer	4,599,234	July 8, 1986
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In the final rejection mailed December 28, 1993 (Paper No. 9), the examiner rejected claims 1 and 20 through 22 under 35 U.S.C. § 112, first paragraph; 35 U.S.C. § 101; and 35 U.S.C. § 103 as unpatentable over Amer “and the prior art admitted by applicants in the specification.” The examiner also rejected claim 1 under 35 U.S.C. § 112, second paragraph, as indefinite. However, in the Examiner's Answer mailed March 17, 1995 (Paper No. 18), page 2, section (4), the examiner withdrew the previously entered rejections under 35 U.S.C. § 112, first paragraph; 35 U.S.C. § 101; and 35 U.S.C. § 112, second paragraph. Accordingly, the sole issue remaining for review is whether the examiner erred in rejecting claims 1 and 20 through 22 under 35 U.S.C. § 103 as unpatentable over Amer “and the prior art admitted by applicants in the specification.”

On consideration of the record, we shall not sustain this rejection.

Discussion

First, in rejecting claims 1 and 20 through 22 under 35 U.S.C. § 103, the examiner relies on a combination of Amer and “admitted prior art in the specification” (Examiner's Answer, page 3, line 6). According to the examiner, this passage in applicants' specification, paragraph bridging pages 7 and 8, constitutes admitted prior art:

Several of the antioxidants, vitamins and minerals contained in the formulation have been shown to inhibit the induction of cancer at several stages in the multistage process. For example, B-carotene, glutathione, cysteine, BHA, BHT, Vitamins A, C and E, as well as selenium, inhibit the tumor initiation, promotion and progression stages of cancer. The heretofore unrecognized synergistic effects of BHA and Vitamin E, for example, may be related to the observations that BHA inhibits tumor promoter-induced polyamine synthesis, and that Vitamin E inhibits promoter-induced hyperplasia, thus leading to a synergistic effect. Furthermore, Vitamins A, C and E, selenium, BHA, BHT, and propyl gallate inhibit tumor initiation by counteracting the covalent binding of carcinogen to DNA and the mutagenic effect of carcinogens.

We disagree. The foregoing passage appears under the heading “SUMMARY OF THE INVENTION” in the specification, and would not appear to constitute admitted or acknowledged prior art. Rather, the foregoing passage constitutes part of the

description of applicants' invention. Viewing the situation in this light, we find that the examiner has mischaracterized the scope and content of the prior art. This alone constitutes reversible error.

Second, Amer discloses administering a dietary supplement to a lower animal, where the supplement comprises (a) a source of selenium; (b) butylated hydroxytoluene (BHT) or butylated hydroxyanisole (BHA); and (c) β -carotene. Claim 1 on appeal recites a method of administering a dietary supplement to an animal, where the supplement includes (a) BHA or BHT; vitamin E; and beta-carotene. The record further reveals that claim 1 is open to the inclusion of selenium. See the instant specification, page 7, lines 25 through 30; and the Appeal Brief filed December 2, 1994 (Paper No. 17), page 11, lines 11 through 13. On these facts, we think it apparent that the difference between the method sought to be patented in claim 1 and the method disclosed by Amer is the recitation of vitamin E in claim 1. That is, applicants' dietary supplement contains vitamin E which is not disclosed or suggested within the four corners of Amer. The examiner, however, mischaracterizes the difference between applicants' claimed subject matter and the closest prior art. According to the examiner, Amer does not expressly disclose a method of inhibiting two-stage skin carcinogenesis-promoting effects of carcinogens in an animal but "generically" discloses reducing or

negating the effect of carcinogens in lower animals (Examiner's Answer, page 4, lines 1 through 4.) In our judgment, the examiner has focused on a non-existent "difference" between independent claim 1 and Amer, but missed the boat respecting the real difference, i.e., vitamin E. This also constitutes reversible error.

For these reasons, we conclude that the examiner has not established a prima facie case of obviousness of claims 1 and 20 through 22. We therefore find it unnecessary to discuss the declaration evidence, attached to applicants' Appeal Brief and relied on as rebutting any such prima facie case.

Additionally, the file wrapper does not reflect that the examiner conducted a computerized search. On return of this application to the examining corps, we recommend that the examiner ensure that all relevant electronic databases have been searched.

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The examiner's decision rejecting claims 1 and 20 through 22 under 35 U.S.C.
§ 103 as unpatentable over the combination of Amer and “admitted prior art in the
specification” is reversed.

REVERSED

Sherman D. Winters
Administrative Patent Judge

William F. Smith
Administrative Patent Judge

Donald E. Adams
Administrative Patent Judge

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